



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,531	11/28/2000	James F. Young	10271-021-999	7010

20583 7590 04/04/2006

JONES DAY  
222 EAST 41ST ST  
NEW YORK, NY 10017

EXAMINER

CHEN, STACY BROWN

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Continuation of Disposition of Claims: Claims pending in the application are 1,3-5,179-184,186,187,189,192,193,195,201,204-212,222-227,231-233,241,242,244,245,250,280-299,303 and 305-323.

Continuation of Disposition of Claims: Claims rejected are 1,3-5,179-184,186,187,189,192,193,195,201,204-212,222-227,231-233,241,242,244,245,250,280-299,303 and 305-323.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment filed January 13, 2006 is acknowledged and entered. Claims 1, 3-5, 179-184, 186, 187, 189, 192, 193, 195, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 280-299, 303 and 305-323 are pending.

### ***Double Patenting***

2. The rejection of claim 180 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of US Patent 6,656,467, is withdrawn in view of the terminal disclaimer filed October 5, 2005.

The provisional rejection of claims 3, 180 and 182 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 55-58 of US Patent 6,818,216, is withdrawn in view of the terminal disclaimer filed October 5, 2005.

3. (*New Rejection*) Claims 1, 3, 5, 179, 180, 182, 186, 187, 206, 212, 280-287 and 320-323 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 87, 88 and 90-118 of copending Application No. 10/020,354.

Art Unit: 1648

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim sets encompass antibodies having SEQ ID NO: 48, 10, 19, 20, 39, 5 and 6.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. On December 15, 2005, a Notice of Allowability for 10/020,354 was mailed to Applicant.

4. The rejection of claim 308 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US Patent 5,824,307) is withdrawn in view of Applicant's amendment to claim 308. Claim 308 is now drawn to an isolated antibody comprising a complementarity determining region (CDR) having an amino acid sequence of a variable light (VL) CDR1 or VL CDR2 of the antibody P12F2. Johnson does not teach SEQ ID NO: 21 or 27 (CDR1 and CDR2, respectively).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(*New Rejection*) Claims 1, 3-5, 179-184, 186, 187, 189, 192, 193, 195, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 280-299, 303 and 305-323 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All of the claims recite, "having an amino acid sequence". It is unclear whether Applicant intends for the claims to encompass antibodies/compositions/kits comprising the entire sequence that is recited in the claim, or a portion of the sequence. For example, claim 1 could be interpreted two ways: an

Art Unit: 1648

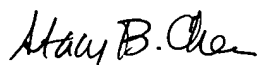
antibody comprising a variable heavy domain having a portion of amino acid sequence of SEQ ID NO: 48, or an antibody comprising a variable heavy domain having the entire amino acid sequence of SEQ ID NO: 48. The claims should be amended to clearly reflect the metes and bounds of the claims. Suggested language is, "An isolated antibody comprising a variable heavy (VH) domain having the amino acid sequence of SEQ ID NO: 48".

### *Conclusion*

6. No claim is allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Stacy B. Chen  
March 28, 2006